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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,741	06/16/2000	Terri Sorge	13237-2580 MS #149442.1	1660

7590 01/12/2004

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EXAMINER
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BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 01/12/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

**Application No.**

09/595,741

**Applicant(s)**

SORGE ET AL.

**Examiner**

Douglas B Blair

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 11/12/2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Number 6,405,225 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. The double patenting rejection with regard to U.S. Patent Number 6,405,225 has been withdrawn.

### ***Response to Amendment***

3. Claims 1-49 are currently pending in this application.
4. The rejection of claim 19 based on U.S.C. 112 2<sup>nd</sup> paragraph is withdrawn.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 4-5, 12, 19-20, 22-23 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,529,942 to Gilbert.

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7. These rejections as the same as those presented in the previous office action (Paper No. 4).

*Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-8, 11, 13-14, 16-18, 24-26, 29, 31-32, 34-36, 37, 39-41, 44-45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,157,934 to Khan et al..
10. These rejections as the same as those presented in the previous office action (Paper No. 4).
11. Claims 3, 9-10, 21, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 5,748,188 to Hu et al..
12. These rejections as the same as those presented in the previous office action (Paper No. 4).
13. Claims 12 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert.

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14. As to claim 30, Gilbert teaches the computer system of claim 19, wherein the document comprises a spreadsheet document or file; however Gilbert does not explicitly teach the use of a word processing document.

Official notice is taken that it would have been obvious at the time of the invention to use a word processing document because Gilbert already provides an email editor with word processing functionality.

15. As to claim 12, it features the same limitations as claim 30 and is there for rejected for the same reasons as claim 30.

16. Claims 15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,542,923 to Nguyen.

17. These rejections as the same as those presented in the previous office action (Paper No. 4).

18. Claims 38 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,529,942 to Gilbert in view of U.S. Patent Number 6,157,934 to Khan et al. as applied to claim 37 above, and further in view of U.S. Patent Number 5,748,188 to Hu et al..

19. These rejections as the same as those presented in the previous office action (Paper No. 4).

### ***Response to Arguments***

20. Applicant's arguments filed 11/12/2003 have been fully considered but they are not persuasive. The applicant argues the following points: (a) The Gilbert reference does not receive a portion of a document and code that portion for transmission as electronic mail; (b) The Gilbert

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reference does not do coding in response to a send command; (c) Khan does not explain how he proposes to link the client and server other than to say by electronic mail or by the Internet; (d) the Gilbert-Khan combination does not teach receiving a pre-selected portion of a document, and in response to a send command, coding the pre-selected portion into an e-mail message, detecting a command to apply interactive control to the pre-selected portion, and in response to receiving a command to apply interactive control, coding an interactive control for the pre-selected portion and inserting the coded interactive control into the e-mail message; (e) it is not clear to the applicants as to where Khan teaches a send button that responds to the content of a pre-selected portion; (f) It is not clear how Khan proposes that cells be linked; and (g) Khan does not teach that the interactive control in applicants' invention enables a recipient to manipulate the content of the pre-selected portion.

21. As to point (a), the text format commands are considered code for manipulating the document. These commands are received from the email sender.
22. As to point (b), the text format commands are coded when the message is sent.
23. As to point (c), the applicants' claims do not explain how to link the client and server other than to say by electronic mail or by the Internet.
24. As to point (d), Gilbert teaches all of these features in the cited portion (col. 4, lines 54-67 and col. 5, lines 1-18). The email program receives portion of the document to code from the sender, when sent the email program codes this portion into the document to be sent. The coded portion is interactive in that it is dependent upon how the user wants to code it. Furthermore Khan teaches interacting with a spreadsheet and then coding the spreadsheet for transmission via email.

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25. As to point (e), Khan teaches an email system therefore a send button is inherent.
26. As to point (f), it is unclear as to what claim limitation this argument refers to.
27. As to point (g), in the teachings of Khan, once the recipient receives the spreadsheet, he or she can manipulate the content.

### ***Conclusion***

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
29. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B Blair whose telephone number is 703-305-5267. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

Douglas Blair  
December 29, 2003

DBB

  
JACK B. HARVEY  
SUPERVISORY PATENT EXAMINER